

### ***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, Claims 1, 3-8, 10, 12-19, 21-30, 32, and 34-44 are pending in the application, with claims 1, 19, 29, 40, and 41 being the independent claims. Claim 9 has been cancelled without prejudice. Claims 7 and 8 have been amended to more clearly point out and distinctly claim the subject matter of the present invention. Claims 1, 3-7, 10, 12-16, 18-19, 21-26, 28-30, 32, 34-37, and 39-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 971,578 to Walker (hereinafter "Walker").

Claims 1, 3, 5-7, 10, 12, 19, 21, 23, 29, 30, 32, 33, and 40-43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,419,501 to Pinto (hereinafter "Pinto").

Claims 1, 3, 5-7, 10, 12, 19, 21, 23, 29, 30, 32, 33, and 40-43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,532,388 to Batt, Jr. (hereinafter "Batt").

Claims 1, 3, 5-7, 10, 12-14, 19, 21, 23-24, 28-30, 32, 33, 34-35 and 40-43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,465,885 to Trump (hereinafter "Trump").

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Pinto in further view of Batt in further view of Trump.

Claims 17, 27, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Pinto in further view of Batt in further view of Trump in further view of U.S. Patent No. 6,821,427 to Macpherson (hereinafter "Macpherson").

Based on the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

I. **Claims 1, 3-7, 10, 12-16, 18-19, 21-26, 28-30, 32, 34-37, and 39-44 are patentable over Walker.**

Claims 1, 3-7, 10, 12-16, 18-19, 21-26, 28-30, 32, 34-37, and 39-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Walker. For the following reasons, this rejection is respectfully traversed.

Independent claims 1, 19, and 41 recite a “bypass adapted to provide a first alternative route for fluid to pass through said apparatus.” Independent claim 29 recites “a bypass means” and Independent claim 40 recites “a bypass route.” These bypasses are absent in Walker. Claims 3, 21, and 32 recite “wherein said filter element comprises a filter cartridge.” Walker fails to disclose or suggest a filter cartridge. Claims 4 and 22 recite “wherein said one or more fluid treatment elements comprises a plurality of filter cartridges.” Claims 13 and 28 recite “a secondary bypass.” Claim 35 recites “a secondary means for bypassing said fluid treatment means.” Claims 16 and 26 recite “wherein at least a portion of fluid passing through said second outlet is potable water.” Claim 37 recites “wherein at least a portion of fluid passing out of said apparatus is potable water.” Claim 18 recites a valve “adapted to direct fluid toward one or more downspout outlets, toward one or more other destinations, or some combination thereof.”

Because at least Walker fails to disclose each and every element of the claims and does not anticipate applicant’s invention, Walker does not anticipate applicant’s invention.

Walker does not disclose a bypass route. Pipes 2 and 16 in Walker lead to a cistern and sewer respectively (see Walker, page 1, lines 47-48 and lines 90-91). In Walker, water is directed to the cistern by configuring the pipes as shown by the solid lines of Figure 2 (see Walker, page 1, lines 34-38) or to the sewer by configuring the pipes as shown by the dotted lines of Figure 2 (see Walker, page 2, lines 13-25). The configuration in Figure 1 shows water directed into a catch barrel or other receptacle (see Walker, page 1, lines 31-34). In each of the three possible configurations water flows to a different outlet by a different path (see, e.g. Walker, page 2, lines 35-43; page 1, lines 50-57).

Examiner identifies 3 separate water paths in Walker, namely, “the first flow route 6,” “the second route 19,” and “third route (16).” See Action, p. 2. Examiner further states that “the

first two flow routes intersect at the same outlet 2.” Action, p. 5. Applicant respectfully disagrees with Examiner’s statement and characterization of Walker.

While the figure in Walker may appear to disclose flow routes intersecting at outlet 2, the written specification makes it clear that is not the case. The specification states that “[s]ecured to the pipe 2 below the upper end of the same and leading laterally therefrom is an elbow 5 which communicates with the interior of said pipe and the upper side of which extends across the bore of the pipe so as to form a partition which will effectually prevent flow through the pipe above the partition.” Walker, p. 1, ll. 50-58 (emphasis added). Walker also adds that in the position depicted in Figure 1, the pipe is positioned “in front of the downspout and the pipe 2...so that water may be caught in a barrel or other receptical” not the cistern to which pipe 2 leads. Walker, p. 2, ll. 35-42. Thus, in Walker water may only take a single path to each outlet and therefore, Walker does not disclose or suggest a route to an outlet as well as a bypass or alternate path to the same outlet.

Additionally, as noted before, Walker does not disclose or suggest a contained, compact apparatus. Applicant’s invention is an apparatus that provides a route for fluid to pass through the apparatus as well as an alternative route for fluid to pass through to the same destination. Walker, on the other hand, provides a configuration of pipes that that may “direct water to any desired point” (page 2, lines 51-52). Walker thus fails to disclose or suggest every element of the claim and the rejection is respectfully traversed.

**II. Claims 1, 3, 5-7, 10, 12, 19, 21, 23, 29, 30, 32, 34, and 40-43 are patentable over Pinto.**

Claims 1, 3, 5-7, 10, 12, 19, 21, 23, 29, 30, 32, 34, and 40-43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pinto. For the following reasons, this rejection is respectfully traversed.

Independent claims 1, 19, and 41 recite a “bypass adapted to provide a first alternative route for fluid to pass through said apparatus.” Independent claim 29 recites “a bypass means” and Independent claim 40 recites “a bypass route.” These bypasses, bypass means, and bypass

routes are absent in Pinto.

Pinto fails to disclose or suggest any type of bypass, bypass means, or bypass route and likewise fails to provide for an alternative path for water flow around Filter 11, Filter 18, and Filter 21 in Figures 1, 4, and 5. Note that in Pinto, the filtering process is provided by a combination of either Filter 18 or 21 working in conjunction with Filter 11. See Column 2, ll. 26-27 (“[Filter 11] provides a very satisfactory type of screen for the final filtering step”) (emphasis added). Because, at least, Pinto fails to disclose a bypass, bypass means, or bypass route, Pinto does not disclose each and every element of the claims and does not anticipate applicant’s invention.

Claims 3, 21, and 32 recite “wherein said filter element comprises a filter cartridge.” Batt fails to disclose or suggest a filter cartridge. Because, at least, Pinto fails to disclose a filter cartridge, Pinto does not disclose each and every element of the claims and does not anticipate applicant’s invention.

**III. Claims 1, 3, 5-7, 10, 12, 19, 21, 23, 29, 30, 32, 34, and 40-43 are patentable over Batt.**

Claims 1, 3, 5-7, 10, 12, 19, 21, 23, 29, 30, 32, 34, and 40-43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Batt. For the following reasons, this rejection is respectfully traversed.

Independent claims 1, 19, and 41 recite a “bypass adapted to provide a first alternative route for fluid to pass through said apparatus.” Independent claim 29 recites “a bypass means” and Independent claim 40 recites “a bypass route.” These bypasses, bypass means, and bypass routes are absent in Batt.

Examiner cites the spacing in Batt between the filter and the inner surface of the casing as a bypass route. However, a careful reading of Batt reveals this is not the case. Batt specifically states that “by virtue of the spacing of the filter unit with respect to the casing, the passage of water through the filter will not be obstructed.” Column 2, ll. 47-49. However, Batt acknowledges that the walls of the casing may not provide an alternative route because the casing may be directly adjacent to the filter. Column 2, ll. 34-36 (“the size of the [filter] unit is such that it is spaced virtually on all sides from the walls of the casing 11...”). Likewise, Batt states

that the “the open end of the filter unit is disposed adjacent to the inlet duct 15....” Column 2, ll. 27-28. It should also be noted that the casing in Batt is not water proof and does not provide an alternative route for water to flow. See Column 2, ll. 17-18. Thus, Batt does not provide a bypass, bypass route, or bypass means. Because, at least, Batt fails to disclose a bypass, bypass means, or bypass route, Batt does not disclose each and every element of the claims and does not anticipate applicant’s invention.

Furthermore, Claims 3, 21, and 32 recite “wherein said filter element comprises a filter cartridge.” Batt fails to disclose or suggest a filter cartridge. Because, at least, Batt fails to disclose a filter cartridge, Batt does not disclose each and every element of the claims and does not anticipate applicant’s invention.

**IV. Claims 1, 3, 5-7, 10, 12-14, 19, 21, 23-24, 28-30, 32, 34-35, and 40-43 are patentable over Trump.**

Claims 1, 3, 5-7, 10, 12-14, 19, 21, 23-24, 28-30, 32, 34-35, and 40-43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Trump. For the following reasons, this rejection is respectfully traversed.

Independent claims 1, 19, and 41 recite a “bypass adapted to provide a first alternative route for fluid to pass through said apparatus.” Independent claim 29 recites “a bypass means” and Independent claim 40 recites “a bypass route.” Applicant respectfully disagrees with Examiner’s description of Trump. Trump does not disclose a bypass, bypass means, or bypass route.

Examiner states that “when removable basket filter...become [sic] clogged, all flow is directed to an alternate route to flow through 24 to the same outlet 22.” However, as noted in the specification of Trump, “[i]n the operation of this device, water and debris...flow downwardly through the said primary passageway 27 thereof, the water passing both through the apertures 49 in the upper wall 25 of compartment member 24 and the apertures in the base 50 of tray 23....” Therefore, apertures 49 and 50 may work together to filter debris from water and serve as a single filter, which is not entirely removable. That is reinforced by the Trump specification which says “[s]hould there be such a rapid accumulation of water as to extend above the top of

member 24, the water will be discharged externally through the said overflow outlets 33 at the upper portion of said inlet portion 21.” Column 4, ll. 49-53. Inlet portion 21 contains spaces 33, which discharge overflow. However, these spaces discharge overflow out the top of debris collector unit 15, not outlet 22 and do not provide an *alternative flow route through a bypass*, bypass means, or bypass route. Because, at least, Trump fails to disclose a bypass, bypass means, or bypass route, Trump does not disclose each and every element of the claims and does not anticipate applicant’s invention.

Claims 13 and 28 recite “a secondary bypass.” Claim 35 recites “a secondary means for bypassing said fluid treatment means.” Trump fails to disclose or suggest a secondary bypass or a secondary means for bypassing said fluid treatment means. Because at least Trump fails to disclose a secondary bypass or secondary means for bypassing said fluid treatment means, Trump does not disclose each and every element of the claims and does not anticipate applicant’s invention.

**V. Claim 8 is patentable over Walker in view of Pinto in further view of Batt in further view of Trump.**

As noted above, neither Walker nor Pinto nor Batt nor Trump disclose or suggest the features found in claims 1-7. For at least this reason, Applicant’s invention is patentable over Walker in view of Pinto in further view of Batt in further view of Trump.

Applicant respectfully traverse’s Examiner’s rejection of 102(b) based upon more than 1 patent. Under 102(b), claims may only be rejected if a single piece of prior art discloses each and every element of the claims. Examiner claims that the current application is unpatentable due to 35 U.S.C. § 103(a) obviousness and cites four pieces of prior art and states that Applicant’s invention is “obvious over any of the above prior art reference [sic].” Examiner makes this claim without pointing out how or why Examiner believes Applicant’s invention is obvious or even how all four pieces of prior should be combined to attempt to produce Applicant’s invention. Applicant respectfully submits that Examiner has not made a prima facie case for obviousness.

For at least these reasons, Applicant’s invention is patentable.

**VI. Claims 17, 27, and 38 are patentable over Walker in view of Pinto in further view of Batt in further view of Trump in further view of Macpherson.**

Though Examiner claims unpatentability due to 35 U.S.C. § 103(a) obviousness, Examiner merely cites four pieces of prior art and claims that Applicant's invention is "unpatentable over any of the above prior art references in view of Macpherson." Examiner makes this claim without pointing out how or why Examiner believes Applicant's invention is obvious or even how all four pieces of prior should be combined to attempt to produce Applicant's invention. Applicant respectfully submits that Examiner has not made a prima facie case for obviousness.

Moreover, Claims 17, 27, and 38 are dependent upon Claims 1, 19, and 29, respectively. Claims 1 and 19 recite a "bypass adapted to provide a first alternative route for fluid to pass through said apparatus." Claim 29 recites "a bypass means." As noted above, taken alone or in combination, neither Walker nor Pinto nor Batt nor Trump disclose or suggest the features found in Applicant's invention. Combining Macpherson with these references also fails to disclose or suggest the invention for at least because, as noted above, neither Macpherson nor Walker nor Pinto nor Batt nor Trump disclose or suggest a bypass or alternative route for fluid to pass.

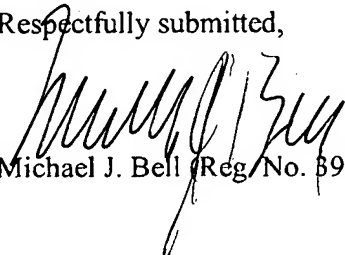
Applicant also respectfully traverses the obviousness of combining Macpherson with the above-mentioned prior art. No motivation to combine these inventions can be found in the patents. For at least because Walker, Pinto, Batt, and Trump deal with filtering debris from water before passing it to another water receptacle, such as a sewer, and therefore preventing clogging, while Macpherson deals with reducing contaminants before releasing them into the environment in compliance with the Clean Water Act (Macpherson, Column 1, ll. 18-35), it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine them.

***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

  
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Date:

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